

REMARKS

I. Introduction

In view of the following remarks, it is respectfully submitted that all of the presently pending claims are allowable, and reconsideration is respectfully requested.

As an initial matter, Applicants respectfully note that the filing date of the present application is December 21, 2001 not December 12, 2001 as stated in the Office Action.

II. Rejection of Claims 1 and 12 to 16 Under 35 U.S.C. § 103(a)

Claims 1 and 12 to 16 were rejected under 35 U.S.C. § 103(a) as unpatentable over the combination of U.S. Patent No. 5,752,177 ("Siegle et al."), U.S. Patent No. 4,250,560 ("Dethloff et al.") and U.S. Patent No. 5,923,817 ("Nakamura"). Applicants respectfully submit that the combination of Siegle et al., Dethloff et al., and Nakamura does not render obvious claims 1 and 12 to 16 for the following reasons.

Claim 1 recites that a device for receiving data via radio signals includes an input device, a radio receiver for receiving data, a processor for processing the data, a memory, and a display for displaying the processed data. Also, claim 1 recites that the input device, when operated once, in the event of a fault, puts the device in a state defined in the memory for playing back the data.

Siegle et al. purport to relate to a radio receiver. The radio receiver includes a receiving part 11, a data memory 21, a display 17, a display unit 22, and a chip card 18. (Col. 2, line 43 to Col. 3, line 11). The radio receiver is used to visually display and/or acoustically output data. The chip card of the radio receiver includes data memory 21 for decoding of the data and for display and/or output of the data. (See Abstract, lines 1 to 7). Siegle et al. do not disclose that the radio receiver includes an input device that during a fault event sets the radio receiver to a state for playing back the data. The disclosure of Siegle et al. is silent as to the operation of the radio receiver during a fault event. Hence, Siegle et al. do not disclose a device for receiving data via radio signals including an input device that, when operated once, in the event of a fault, puts the device in a state defined in the memory for playing back the data, as recited in claim 1.

The Office Action admits that Siegle et al. do “not expressly disclose a processor and input device.” Office Action at p. 2. However, the Office Action alleges, in complete contradiction to the admission that Siegle et al. do “not expressly disclose [an] input device,” that it is “well known for [Siegle et al.’s] input device to be an infrared transceiver.” Office Action at p. 2. These contradictory statements make plain the misapprehension of the cited references and the subject matter of the present claims.

Applicants respectfully traverse all contentions of well-known fact contained in the Office Action to the extent that such contentions are maintained and respectfully request that the Examiner provide specific evidence to establish each and every one of those assertions and/or contentions under 37 C.F.R. § 1.104(d)(2) or otherwise. In particular, it is respectfully requested that the Examiner provide an affidavit and/or that the Examiner provide published information concerning these assertions. This is because this rejection is apparently being based on assertions that draw on facts within the personal knowledge of the Examiner, since no support was provided for these otherwise conclusory and unsupported assertions. (See also MPEP § 2144.03).

Moreover, judicial or official notice that is based on subjective and unsupported reasoning will not sustain an obviousness rejection. In the M.P.E.P. cited case of In re Ahlert, 165 U.S.P.Q. 418, 420-21 (C.C.P.A. 1970)), the Court made plain that:

Assertions of technical facts in areas of esoteric technology must always be supported by citation to some reference work recognized as standard in the pertinent art and the appellant given, in the Patent Office, the opportunity to challenge the correctness of the assertion or the notoriety or repute of the cited reference. **Allegations concerning specific “knowledge” of the prior art, which might be peculiar to a particular art should also be supported and the appellant similarly given the opportunity to make a challenge.**

In re Ahlert, 165 U.S.P.Q. at 420 to 21 (citations omitted).

Otherwise, if the Examiner cannot provide either references or an affidavit to support these contentions, it is respectfully requested that the rejections of the claims under 35 U.S.C. § 103 be withdrawn for this reason alone.

Dethloff et al. purport to relate to a text processing apparatus. The text processing apparatus includes a data storage 1, an electronic control unit 2, an input

device 4, a retrieving device 3, and a charge/retrieve switch 5. The charge/retrieve switch is used to select a desired operating state such as input of data to the data storage 1 or output of data from the data storage 1. (Col. 7, lines 41 to 50). Dethloff et al. describe a text processing apparatus that stores and retrieves data using a data storage. Dethloff et al. do not disclose an input device that during a fault event sets a radio receiver, or any other type of device, to a state for playing back the data. The disclosure of Dethloff et al. is silent as to the operation of the text processing apparatus during a fault event. Hence, Dethloff et al. do not disclose a device for receiving data via radio signals including an input device that, when operated once, in the event of a fault, puts the device in a state defined in the memory for playing back the data, as recited in claim 1.

Nakamura purports to relate to a video data system. This video data system includes a plurality of data generating means that generate video data; a plurality of storage devices for storing video data on a block basis; a plurality of servers for accessing video data stored on the storage devices; a control device for processing video data into block-based recorded video data, calculating a parity value from a predetermined number of the block-based recorded video data bit-to-bit, and transferring the predetermined number of pieces of the block-based recorded video data and the parity value to the plurality of servers horizontally so that the predetermined number of pieces of the block-based recorded data and the parity value are stored in the plurality of storage devices in a predetermined order; and a video data playback device that, if one of the servers has failed when the video data corresponding to one of the data generating means is to be played back while read from the plurality of storage devices through the servers, plays back and displays block-based recorded video data by recovering from the parity value the block-based recorded data stored in a storage device connected to the failed server. (Col. 2, line 61 to Col. 3, line 18). Nakamura describes that when there is a server failure, the video data playback device (an output device) continues to play back video data by recovering from the parity value. Nakamura does not disclose an input device that during a fault event sets a radio receiver, or any other type of device, to a state for playing back the data. The disclosure of Nakamura is silent as to the operation of the plurality of data generating means (input devices) during a fault event. Hence, Nakamura does not disclose a device for receiving data via radio signals including an input device that, when operated once, in the event of a

fault, puts the device in a state defined in the memory for playing back the data, as recited in claim 1.

As discussed above, the combination of Siegle et al., Dethloff et al., and Nakamura does not disclose, or even suggest, a device for receiving data via radio signals including an input device that, when operated once, in the event of a fault, puts the device in a state defined in the memory for playing back the data, as recited in claim 1.

In rejecting a claim under 35 U.S.C. § 103(a), the Examiner bears the initial burden of presenting a prima facie case of obviousness. In re Rijckaert, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). To establish prima facie obviousness, three criteria must be satisfied. First, there must be some suggestion or motivation to modify or combine reference teachings. In re Fine, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). This teaching or suggestion to make the claimed combination must be found in the prior art and not based on the application disclosure. In re Vaeck, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). Second, there must be a reasonable expectation of success. In re Merck & Co., Inc., 800 F.2d 1091, 231 U.S.P.Q. 375 (Fed. Cir. 1986). Third, the prior art reference(s) must teach or suggest all of the claim limitations. In re Royka, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974).

As indicated above, the combination of Siegle et al., Dethloff et al., and Nakamura does not disclose, or even suggest, a device for receiving data via radio signals as recited in claim 1. It is therefore respectfully submitted that the rejection must necessarily fail. Furthermore, the reasons stated in the Office Action that it would have been obvious to combine Siegle et al., Dethloff et al., and Nakamura can only be found in the present application and not in the disclosures of Siegle et al., Dethloff et al., or Nakamura. It is therefore plain that the present rejection is based on nothing more than improper hindsight.

Accordingly, it is respectfully submitted that the cases of In re Fine, supra, and In re Jones, 21 U.S.P.Q.2d 1941 (Fed. Cir. 1992), make plain that the Office Action's generalized assertions that it would have been obvious to modify or combine the references do not properly support a § 103 rejection. It is respectfully submitted that those cases make plain that the Office Action reflects a subjective "obvious to try" standard, and therefore does not reflect the proper evidence to

support an obviousness rejection based on the references relied upon. In particular, the Court in the case of In re Fine stated that:

The PTO has the burden under section 103 to establish a *prima facie* case of obviousness. It can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references. This it has not done. . . .

Instead, the Examiner relies on hindsight in reaching his obviousness determination. . . . One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.

In re Fine, 5 U.S.P.Q.2d at 1598 to 1600 (citations omitted; italics in original; emphasis added). Likewise, the Court in the case of In re Jones stated that:

Before the PTO may combine the disclosures of two or more prior art references in order to establish *prima facie* obviousness, there must be some suggestion for doing so, found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. . . .

Conspicuously missing from this record is any evidence, other than the PTO's speculation (if it be called evidence) that one of ordinary skill . . . would have been motivated to make the modifications . . . necessary to arrive at the claimed [invention].

In re Jones, 21 U.S.P.Q.2d at 1943, 1944 (citations omitted; italics in original).

That is exactly the case here since it is believed and respectfully submitted that the present Office Action offers no evidence whatsoever, but only conclusory hindsight, reconstruction and speculation, which these cases have indicated does not constitute evidence that will support a proper obviousness finding. Unsupported assertions are not evidence as to why a person having ordinary skill in the art would be motivated to modify or combine references to provide the claimed subject matter of the claims to address the problems met thereby. Accordingly, the Office must provide proper evidence of a motivation for modifying or combining the reference to provide the claimed subject matter.

More recently, the Federal Circuit in the case of In re Kotzab has made plain that even if a claim concerns a "technologically simple concept" -- which is not

the case here -- there still must be some finding as to the “specific understanding or principle within the knowledge of a skilled artisan” that would motivate a person having no knowledge of the claimed subject matter to “make the combination in the manner claimed,” stating that:

In this case, the Examiner and the Board fell into the hindsight trap. The idea of a single sensor controlling multiple valves, as opposed to multiple sensors controlling multiple valves, is a technologically simple concept. With this simple concept in mind, the Patent and Trademark Office found prior art statements that in the abstract appeared to suggest the claimed limitation. But, there was no finding as to the specific understanding or principle within the knowledge of a skilled artisan that would have motivated one with no knowledge of Kotzab’s invention to make the combination in the manner claimed. In light of our holding of the absence of a motivation to combine the teachings in Evans, we conclude that the Board did not make out a proper prima facie case of obviousness in rejecting [the] claims . . . under 35 U.S.C. Section 103(a) over Evans.

In re Kotzab, 55 U.S.P.Q.2d 1313, 1318 (Fed. Cir. 2000) (emphasis added). Again, it is believed that there have been no such findings.

Accordingly, there is no evidence that the references relied upon, whether taken alone, combined or modified, would provide the features and benefits of claim 1. It is therefore respectfully submitted that claim 1 is allowable for these reasons.

As for claims 12 to 16, which ultimately depend from claim 1 and therefore include all of the limitations of claim 1, it is respectfully submitted that the combination of Siegle et al., Dethloff et al. and Nakamura does not render unpatentable these dependent claims for at least the same reasons given above in support of the patentability of claim 1. In re Fine, supra (any dependent claim that depends from a non-obvious independent claim is non-obvious).

In view of all of the foregoing, withdrawal of this rejection is respectfully requested.

III. Rejection of Claims 2 to 5 and 11 Under 35 U.S.C. § 103(a)

Claims 2 to 5 and 11 were rejected under 35 U.S.C. § 103(a) as unpatentable over the combination of Siegle et al., Dethloff et al., Nakamura and U.S. Patent No. 5,086,510 (“Guenther et al.”). Applicants respectfully submit that

the combination of Siegle et al., Dethloff et al., Nakamura, and Guenther et al. does not render obvious claims 2 to 5 and 11 for the following reasons.

Claims 2 to 5 and 11 ultimately depend from claim 1. It is respectfully submitted that Siegle et al., Dethloff et al., Nakamura, and Guenther et al., whether taken alone or combined, do not in any way describe, or even suggest, a device for receiving data via radio signals including an input device that, when operated once, in the event of a fault, puts the device in a state defined in the memory for playing back the data, as recited in claim 1, for essentially the same reasons discussed above with respect to the combination of Siegle et al., Dethloff et al., and Nakamura.

Accordingly, it is respectfully submitted that claims 2 to 5 and 11 are allowable for the same reasons as claim 1, since Guenther et al. do not cure the critical deficiencies of Siegle et al., Dethloff et al., and Nakamura.

IV. Rejection of Claims 6 to 10 Under 35 U.S.C. § 103(a)

Claims 6 to 10 were rejected under 35 U.S.C. § 103(a) as unpatentable over the combination of Siegle et al., Dethloff et al., Nakamura, Guenther et al. and U.S. Patent No. 4,342,095 ("Goodman"). Applicants respectfully submit that the combination of Siegle et al., Dethloff et al., Nakamura, Guenther et al., and Goodman does not render obvious claims 6 to 10 for the following reasons.

Claims 6 to 10 ultimately depend from claim 1. It is respectfully submitted that Siegle et al., Dethloff et al., Nakamura, Guenther et al., and Goodman, whether taken alone or combined, do not in any way describe, or even suggest, a device for receiving data via radio signals including an input device that, when operated once, in the event of a fault, puts the device in a state defined in the memory for playing back the data, as recited in claim 1, for essentially the same reasons discussed above with respect to the combination of Siegle et al., Dethloff et al., and Nakamura.

Accordingly, it is respectfully submitted that claims 6 to 10 are allowable for the same reasons as claim 1, since Goodman does not cure the critical deficiencies of Siegle et al., Dethloff et al., Nakamura, and Guenther et al.

V. Conclusion

It is therefore respectfully submitted that all of the presently pending claims are allowable. All issues raised by the Examiner having been addressed, an early and favorable action on the merits is earnestly solicited.

Respectfully submitted,

KENYON & KENYON

Dated: May 26, 2004

By:

Richard L. Mayer
Richard L. Mayer
Reg. No. 22,490

*Reg. No.
42,194*

One Broadway
New York, New York 10004
(212) 425-7200

CUSTOMER NO. 26646